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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,643	02/10/2004	Donald A. Cronin	4541-009	1297
67419	7590	03/12/2009	EXAMINER	
COATS & BENNETT/IBM 1400 CRESCENT GREEN SUITE 300 CARY, NC 27518			SENSENIG, SHAUN D	
		ART UNIT	PAPER NUMBER	
		3629		
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		03/12/2009		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/775,643	CRONIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shaun Sensenig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
  - 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date ____ .	6) <input type="checkbox"/> Other: ____ .

## DETAILED ACTION

This action is in response to papers filed on January 15, 2009.

Claims 1-4, 14-17, 23, 26, 28, and 29 have been amended.

Claim 30 has been cancelled.

No claims have been added.

Claims 1-29 are pending.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-22** are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must entail the use of a specific machine or transformation of an article which must impose meaningful limits on the claim's scope to impart patent-eligibility. See *Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Parker v. Flook*, 437 U.S. 584, 590 (1978). The "computer", as presented in claims 1 and 14, performs the insignificant extra-solution activity of displaying without performing any processing activities. Moreover, while the claimed process contains physical steps (displaying, identifying, generating, combining, selecting), it does not involve transforming an article into a different state or thing. Therefore, Applicants' claim is not drawn to patent-eligible subject matter under §

101.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 5-9, and 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan, JR. et al. (Pub. No. US 2003/0005090 A1) (hereafter referred to as Sullivan).**

5. In regards to **Claim 1**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system, the method comprising:

displaying a plurality of domains on a display to a user, each domain identifying a functional area to consider when designing the e-business system, and comprising a list of one or more patterns that identify software components associated with the domain; (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0021], lines 4-5; and [0058], *shows domains (hardware and software resources) that are made up of patterns (services)*)

identifying one or more domains, from the plurality of domains being displayed to the user; ([0021], lines 4-5; [0057], lines 1-2; and [0058], *identifies examples of domains (resources)*)

selecting and combining patterns to define components of the system; ([0083], lines 4-5 and [0085], *shows patterns (services) being combined to form a model (defining) of the system*)

displaying said multi-domain pattern to the user on the display. (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0083], lines 4-5; and [0085], *shows patterns (services) being combined to form a model (defining) of the system*)

1. In regards to **Claims 5-9**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system incorporating domains and patterns. ([0021], lines 4-5 and [0058])

As far as the particular non-functional descriptive material to describe/label/name the domains and patterns, it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

2. In regards to **Claim 11**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system further comprising implementing said e-business system according to said multi-domain pattern. ([0079])

3. In regards to **Claim 12**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-

business system wherein said multi-domain pattern defines one or more hardware components in said e-business system. ([0018], lines 6-15 and [0021], lines 4-5)

4. In regards to **Claim 13**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system wherein said multi-domain pattern defines one or more software components in said e-business system. ([0018], lines 6-15 and [0021], lines 4-5)

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claims 2-4, 10, and 14-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan in view of Chan et al. (Pub. No. US 2005/0021348 A1) (hereafter referred to as Chan).**

8. In regards to **Claims 2-4, 14, and 20**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system, the method comprising:

identifying a plurality of domains, from domains being displayed on a display to a user, each said domain identifying a functional area to consider when designing the e-business system, and comprising a list of one or more patterns that identify software components associated with the domain; (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0021], lines 4-5; [0057], lines 1-2; and [0058], *shows domains (hardware and software resources) that are made up of patterns (services) and identifies examples of domains (resources)*)

generating a multi-domain pattern based on said set of patterns, said multi-domain pattern defining one or more software components for one or more of the domains of said e-business system; ([0083], lines 4-5 and [0085], *shows patterns (services) being combined to form a model (defining) of the system*) and

displaying said multi-domain pattern to the user on the display. (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0083], lines 4-5; and [0085], *shows patterns (services) being combined to form a model (defining) of the system*)

Sullivan discloses all of the above limitations. Sullivan does not explicitly disclose selecting design choices based on a set of criteria, however, Chan teaches:

selecting design choices based on a set of criteria (Abstract, lines 10-13, *shows solutions incorporating user criteria (parameters)*; [0006])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included the selecting design choices based on a set of criteria taught by Chan in order to ensure usability and efficiency of the design by ensuring that it addresses the needs and requirements of the user, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Neither Sullivan nor Chan explicitly disclose narrowing the design choices and narrowing the criteria that they are based on, however, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Sullivan so as to have included the narrowing of the design choices and narrowing of the criteria that they are based on in order to ensure usability and efficiency of the design by ensuring that the selected design choices were as specific to the requirements and needs of the user as possible , since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

9. In regards to **Claims 10 and 27**, Sullivan does not explicitly disclose storing selected design choices in a database, however, Chan teaches:

storing selected design choices in a database (Fig. 3A, Fig. 3B, [0059], and [0075])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included storing selected design choices in a database as taught by Chan in order to ensure usability

and efficiency of the design by ensuring that records of information and activities can be saved for future reference, recovery and/or use, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

10. In regards to **Claims 15 and 16**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system wherein there are criteria.

Sullivan discloses all of the above limitations. Sullivan does not explicitly disclose selecting design choices based on a set of criteria, however, Chan teaches: selecting design choices based on a set of criteria (Abstract, lines 10-13, and [0006])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included the selecting design choices based on a set of criteria taught by Chan in order to ensure usability and efficiency of the design by ensuring that it addresses the needs and requirements of the user, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

As far as the particular non-functional descriptive material to describe/label/name the types of criteria, it has been deemed merely intended usage of the claim and therefore accorded no patentable weight.

11. In regards to **Claims 17, 18 and 26**, Sullivan does not explicitly disclose storing criteria in a database, however, Chan teaches:

storing criteria in a database (Fig. 3A, Fig. 3B, [0059], and [0075])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included storing criteria in a database as taught by Chan in order to ensure usability and efficiency of the design by ensuring that records of information and requirements can be saved for future reference, recovery and/or use, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

12. In regards to **Claim 19 and 25**, Sullivan discloses:

A method, performed on a computing device, of designing and building an e-business system wherein selecting a first set of patterns from one or more said domains comprises displaying potential conflicts between said patterns in said first set of patterns. ([0084], lines4-6 and [0085], lines 4-10)

13. In regards to **Claim 21**, Sullivan does not explicitly disclose storing design information in a database, however, Chan teaches:

storing design information in a database (Fig. 3A, Fig. 3B, [0059], and [0075])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included storing design information in a database as taught by Chan in order to ensure usability and efficiency of the design by ensuring that records of information and activities can be saved for future reference, recovery and/or use, since doing so could be performed readily and

easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

14. In regards to **Claim 23 and 28**, Sullivan discloses:

A system for designing and building an e-business system comprising:

- (a) a server; (Fig. 4, *shows multiple servers*)
- (b) a database communicatively linked to said server; (Fig. 4, *shows database (142) linked to multiple servers*) and
- (c) a controller communicatively linked to said server and said database, said controller adapted to: (Fig. 4 and Claim 2, *shows controller linked to database and multiple servers as part of system*)
  - display one or more domains to a user, wherein each said domain identifies a functional area to consider when designing the e-business system, and includes a list of one or more patterns that identify software components associated with the domain; (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0021], lines 4-5; and [0058], *shows domains (hardware and software resources) that are made up of patterns (services)*)

generating a multi-domain pattern based on said set of patterns, said multi-domain pattern defining one or more software components for one or more of the domains of said e-business system ([0083], lines 4-5 and [0085], *shows patterns (services) being combined to form a model (defining) of the system*)

display said multi-domain pattern to the user on the display. (Abstract, lines 11-16, *shows components being displayed (interface) to user for manipulation*; [0083], lines 4-5; and [0085], *shows patterns (services) being combined to form a model (defining) of the system*)

Sullivan discloses all of the above limitations. Sullivan does not explicitly disclose selecting design choices based on a set of criteria, however, Chan teaches: selecting design choices based on a set of criteria (Abstract, lines 10-13, *shows solutions incorporating user criteria (parameters)*; [0006])

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Sullivan so as to have included the selecting design choices based on a set of criteria taught by Chan in order to ensure usability and efficiency of the design by ensuring that it addresses the needs and requirements of the user, since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In addition to the above rejection, the material following the phrase "...adapted to..." has been deemed to contain merely non-functional descriptive material and therefore given no patentable weight.

15. In regards to **Claim 24**, Sullivan discloses:

A system for designing and building an e-business system further comprising a workstation communicatively linked to said server and said database. (Fig. 3 and [0065], lines 1-8)

16. In regards to **Claim 29**, Neither Sullivan nor Chan explicitly disclose narrowing the design choices and narrowing the criteria that they are based on, however, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the system of Sullivan so as to have included the narrowing of the design choices and narrowing of the criteria that they are based on in order to ensure usability and efficiency of the design by ensuring that the selected design choices were as specific to the requirements and needs of the user as possible , since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

### ***Response to Arguments***

1. Applicant's arguments filed January 15, 2009 have been fully considered but they are not persuasive.

2. I. Rejection of Claims under 35 U.S.C. §101

Applicant argues that The Federal Circuit determined that "*the electronic transformation of raw data into a particular visual depiction of specific physical objects on a display renders a data processing claim eligible for patent protection under §101*".

In Applicant's claims, information is simply displayed to a user for manipulation.

Applicant does not show, in the claims, that raw data is transformed into a visual depiction in any way (including transformation from an underlying physical object). The simple act of gathering or recording information, then displaying it is not significant enough to render a claim patentable under §101. Additionally, as presented the claims

could be performed using a paper and pencil or set of cads or other similar medium.

The steps of displaying and identifying could be done on such a visual medium, and the steps of generating and combining could be performed by rearranging drawing items

3. II. Rejection of Claims under 35 U.S.C. §103

Applicant 's arguments in regards to the 35 U.S.C. §103 rejections are moot in view of the new prior art rejections.

***Conclusion***

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Calver (Pub. No. US 2001/0032092 A1), Goh et al. (Pub. No. US 2005/0096968 A1), Golub et al. (Patent Number 5,050,090), Fletcher (Patent No. US 7,343,428 B2), Han et al. (Patent No. US 7,496,637 B2).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./  
Examiner, Art Unit 3629  
March 9,2009

/JOHN G WEISS/  
Supervisory Patent Examiner, Art Unit 3629